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REMARKSSummary of Office Action

Claims 1-5, 7-12, 24 and 25 are pending. These claims have been rejected under 35 U.S.C. § 103 (a) as being obvious from Maddox U.S. Patent 1,1340,630 and Picolet U.S. Patent No. 4,492,225.

Applicants' Reply

Applicant respectfully requests careful reconsideration of the previously presented Remarks and presents the following additional Remarks for further consideration. Applicant respectfully traverses the § 103(a) rejections.

Claim 24

The elements of Applicant's independent claim 24 include "apparatus components including *the plate and hinge dimensions and orientation [] configured* so that the apparatus is a *universal tool* for immobilizing any one of different body parts including a shoulder, elbow, knee, wrist and hip corresponding to the different types of joint injuries."

Applicants note that the Office Action alleges "the Maddox/Picolet device is obviously capable of being applied to the above mentioned portions/joints of the body," and further "the Maddox/Picolet device teaches all elements of the claimed invention, therefore, it would obviously would be able to perform the same intended uses".

Applicants note that the Office Action allegations are unsupported by law, fact or reason. Maddox/Picolet do not teach applicant's claim 24 to a person of skill in the art..

Maddox's patent is entitled "Arm-abduction Splint". Maddox's Arm-abduction Splint relates "to surgical devices 15 adapted to retain the arm of the patient any desired position relatively to the body." (See Maddox, col. 1 lines 15-235). Maddox's Arm-abduction Splint is based on an "upper arm: and "fore arm supports" (See Maddox, col. 1 lines 24-30, FIGS. and claims). Maddox' splint design and dimensions are particularly selected to support the arms. Maddox does not show any recognition of or suggest a need to support other body parts in other injuries. In particular, Applicants submit that Maddox does not teach, show or suggest "apparatus components including *the plate and hinge dimensions and orientation [] configured* so that the apparatus is a *universal tool*," which can support any body part.

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Picolet's patent is entitled "Cradles and Minerva jackets, and manufacturing material." In particular, Picolet describes "a surgical cradle for supporting the heads or members of persons or animals comprising a layered panel". (See e.g., Picolet claim 1 and FIGS.). However, Picolet's cradles are body-part specific. ( See e.g., FIGS.). For example, a cradle for a head cannot be used for a leg. In particular, Applicant submits that Picolet does not teach, show or suggest "apparatus components including *the plate and hinge dimensions and orientation [] configured* so that the apparatus is a *universal tool*," which can support any body part.

Therefore, the Office Action mistakenly states "the Maddox/Picolet device teaches all elements of the claimed invention." Neither, Maddox nor Picolet (nor their combination) reasonably suggest or teach claim 24 element : "apparatus components including *the plate and hinge dimensions and orientation [] configured* so that the apparatus is a *universal tool* for immobilizing any one of different body parts including a shoulder, elbow, knee, wrist and hip corresponding to the different types of joint injuries," to a person of skill in the art.

Applicant submits that the obviousness rejection is improper, unsupported and conclusory, and based on hindsight. In particular, applicant notes that the Office Action statements "the Maddox/Picolet device is obviously capable of being applied to the above mentioned portions/joints of the body," and further "the Maddox/Picolet device teaches all elements of the claimed invention , therefore , it would obviously would be able to perform the same intended uses," are incorrect and do not address applicant's claimed element of "apparatus components [having] *dimensions and orientation* [to make] a universal tool."

Applicant submits that modifying Maddox/Picolet device as proposed by the Examiner will defeat the stated purposes of the Maddox and Picolet patents, and render their inventions inoperable.

For any of these reasons, the aforementioned feature of independent claim 24 cannot reasonably be said to be present in or suggested by the asserted combination of Maddox and Picolet.

Further, applicant submits that the obviousness rejection is improper and does not meet the criteria and standards laid out in *Graham v. John Deere*, *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007), the MPEP, and *In re Wada and Murphy*, Appeal 2007-3733

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The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103, despite any recent revision to the Manual of Patent Examining Procedure (MPEP).

Section 2143.03 of the MPEP requires the “consideration” of every claim feature in an obviousness determination. Here, the Office Action fails to consider the limitation “apparatus components including *the plate and hinge dimensions and orientation [] configured so that the apparatus is a universal tool for immobilizing any one of different body parts including a shoulder, elbow, knee, wrist and hip corresponding to the different types of joint injuries.*”

In any case, to render claim 24 unpatentable the Office must do more than merely “consider” each and every feature for this claim. Instead, the asserted combination of the Maddox and Picolet must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” See *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). Further, the necessary presence of all claim features is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... ascertaining the differences between *the claimed invention* and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added). Indeed, Applicant submits that this is why Section 904 of the MPEP instructs Examiners to conduct an art search that covers “*the invention as described and claimed*” (emphasis added). Lastly, Applicant respectfully directs attention to MPEP § 2143, the instructions of which buttress the conclusion that obviousness requires at least a suggestion of all of the features of a claim, since the Supreme Court in *KSR Int’l v. Teleflex Inc.* stated that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

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In sum, it remains well-settled law that obviousness requires at least a suggestion of all of the features in a claim. See *In re Wada and Murphy*, citing *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

Conclusion

For at least the foregoing reasons the § 103(a) rejection of 1-5, 7-12, 24 and 25 is improper and should be withdrawn.

As previously submitted Applicant's representative would be happy to discuss any additional concerns or questions the Examiners may have. Accordingly, the Examiners are invited to contact the undersigned at (425) 667-2872 with any issues that may advance prosecution of the application on the merits.

Respectfully submitted,

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